

REMARKS

Amendments

Changes made to the Application, including the claims, are not made in Reply to any rejection or other communication from the Examiner, but are made to improve the clarity, readability, or understanding of the application or a portion of the application that was changed. As is evident, none of the foregoing amendments was made to add new matter, and none was made to narrow the scope of the claims. Indeed, all amendments were made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

Status of Prosecution

Applicant filed the original application on October 10, 2003. The Examiner mailed a first non-final office action on March 10, 2005. Applicant filed a Reply to that office action on May 3, 2005 that included a Declaration by a person skilled in the art that supported the Reply filed by Applicant. The Examiner mailed a second non-final office action on May 3, 2005, accepting the drawing figure amendments, specification amendments, and withdrawing rejections under 35 U.S.C. §112. This paper is in reply to that office action. Applicant requests reconsideration and withdrawal of the rejections raised in that office action.

Applicant expresses appreciation for the Examiner's professional courtesy of providing a second non-final office action, and thus providing Applicant an opportunity to emphasize the structural differences between Applicant's shaping tool and the apparatus claimed in the references cited by the Examiner for rejecting the claims of Applicant.

Examiner's General Objections and Rejections

Claims 1-25 are pending.

In the Office Action, the Examiner rejected claims 1-25.

For clarity, Applicant notes that claims 1-25 include claims sets 1-10, 11-17, 18-19, and 20-25, and the independent claims are 1, 11, 18 and 20.

On pages 2-3 of the Office Action the Examiner rejected claims 1-13 and 19 under 35 U.S.C. §102(b), stating that those claims were anticipated by U.S. Patent No. 4,057,884 issued on November 15, 1977 to Suzuki ("Suzuki Patent"), an argument that Applicant respectfully traverses.

On page 5 of the Office Action the Examiner rejected dependent claims 14-17 under 35 U.S.C. §103(a), stating that claim 18 is obvious over the Suzuki Patent”), an argument that Applicant respectfully traverses.

On page 5 of the Office Action the Examiner rejected independent claim 18 under 35 U.S.C. §103(a), stating that claim 18 is obvious over the Suzuki Patent”), an argument that Applicant respectfully traverses.

On pages 5-6 of the Office Action the Examiner rejected independent claim 20 and dependent claim 21 under 35 U.S.C. §103(a), stating that those claims were obvious over the Suzuki Patent in view of U.S. Patent 6,279,919 issued August 28, 2001 to Turos (“Turos Patent”), an argument that Applicant respectfully traverses. The inventor in connection with the Turos Patent and the Application under examination are the same.

On page 6 of the Office Action the Examiner rejected dependent claims 22-25 that depend from independent claim 20 under 35 U.S.C. §103(a), stating that those claims are obvious over the Suzuki Patent in view of the Turos Patent in further view of U.S. Patent No. 1,435,288 issued on October 10, 1921 to Gifford, *et al.* (“Gifford Patent”), an argument that Applicant respectfully traverses.

Applicant respectfully urges, therefore, that the rejections of the Examiner be withdrawn.

Rejection Under 35 U.S.C. §102(b)

On pages 5-6 of the Office Action the Examiner rejected claims 1-9, 11-13 and 19 under 35 U.S.C. §102(b), stating that those claims were anticipated by U.S. Patent No. 4,057,884 issued on November 15, 1977 to Suzuki (“Suzuki Patent”).

35 U.S.C. §102 (b) provides:

“A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....”

Applicant respectfully submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale

in this country, more than one year prior to the date of filing of the present application in the United States.

Specifically, the Suzuki Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

5 A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

10 Contrary to the Examiner’s suggestion that all elements are disclosed in the Suzuki Patent, a tongue as disclosed and claimed in the Application is not, so the rejections of at least independent claims 1 and 11 are unsupported, and therefore should be withdrawn.

“Indexing Recesses” vs. Variable Positionable

15 The following remarks apply to all discussions of the Suzuki Patent in this paper.

As emphasized by the Examiner, a limitation of the Suzuki Patent is a “series of indexing recesses (5) spaced from each other at an angle of 15 degrees over a range of 180 degrees....” (See Office Action, pages 2-3.) The indexing recesses serve to allow only limited ratchet-like pivotal movement of the body portion (2) into predetermined fixed positions.

20 Applicant’s shaping tool is not so limited. Applicant’s shaping tool provides a swivel member that is variably positionable at any desired acute angle; the swivel member may be position in any predetermined position within an acute angle.

Those structural differences, and the difference in cooperation of the structural elements, confirm that the Suzuki apparatus fails to satisfy the all-elements test for anticipation.

25 More specifically, the Suzuki Patent includes the limitation that for “fixing the angular position of the tool bit 8 or the tool bit supporting member 1 relative to the shank 11...there is provided indexing means comprising the angularly spaced recesses 5...and a position adjusting and fixing screw 25...for selectively engaging one of the recesses 5....” See Suzuki Patent, column 2, lines 20-29, emphasis added. The indexing means permit only indexing pivotal movement, not variable pivotal movement. See Suzuki Patent, column 1, lines 19-21.

30 Applicant’s swivel member, however, can be positioned at any desired acute angle. “The shaping tool may be locked into variable desired positions and attitudes during operation.” See

Application, page 2, lines 12-13. The specification of the Application also provides at page 3, lines 28-30:

Partially beveled edge 28 is positioned in slot 18 to enable partially beveled edge 28 to make contact with the back surface 30 of slot 18, thus contributing to the capability of locking swivel member 12 and cutter 14 in desired positions and attitudes during operation. During operation of shaping tool 10, a craftsman may adjust swivel member 12 in an acute angle formed in relationship to the longitudinal axis through arm 16 varying from zero degrees through approximately 35 degrees.

The Detailed Description emphasizes that a “craftsman also may adjust and temporarily fix in a desired position acute angle A during shaping work by using key 62 as perhaps best shown in Figure 3.” See Application, page 5, lines 11-14.

Claim Amendments

The structure and cooperation of structure that thus distinguishes the disclosure and claims of Applicant therefore are clear. Applicant’s claim 1 expressly provides that the “coupler is formed to adjustably position the swivel member at an acute angle to the longitudinal axis through the arm,” and also claims “means for locking the swivel member and cutter into a range of desired positions during shaping operations.” See Application, page 8, lines 6-11. According, no claim amendment is required for clarification.

Likewise, independent claim 18 is directed to a “variable angle tool for shaping a rotating workpiece,” which is also clear.

Applicant has amended independent claims 11 and 20 to more clearly emphasize the variable angle feature of Applicant’s shaping tool. Support for the amendments is found in the Application at the pages identified above.

It follows, therefore, that contrary to the Examiner’s argument that all elements are disclosed in the Suzuki Patent, the Suzuki Patent does not disclose a variably positionable swivel member, so the rejections of at least independent claims 1 and 11 are unsupported, and therefore should be withdrawn.

As regards the dependent claims rejected by the Examiner for anticipation by the Suzuki Patent, 2-10, 12-13 and 19, because Applicant has distinguished the cited reference and amended independent claim 11, the independent claims are now allowable, and the dependent claims likewise are also allowable.

Discussion of Rejections under 35 U.S.C. §102

For fundamental teaching on the doctrine of anticipation, one must consider the decision of Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Our review of a finding of anticipation is the same whether it was made by the board or by a district court.

In re William J. King at 231 USPQ 139 (emphasis added).

Further, for a reference to anticipate a claim under 35 U.S.C. §102, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added).

Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Emphasis added.) As discussed above, the Suzuki Patent does not disclose the identical structure and cooperation of structure as described in the Application examined by the Examiner. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Therefore, Applicant respectfully urges that the cited reference does not anticipate Applicant’s shaping tool, and that the rejections be withdrawn.

First Rejection under 35 U.S.C. §103(a)

On page 5 of the Office Action the Examiner rejected dependent claims 14-17 under 35 U.S.C. §103(a), stating that claim 18 is obvious over the Suzuki Patent”), an argument that Applicant respectfully traverses.

35 U.S.C. §103 provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5

Applicant respectfully submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

10

Moreover, as stated in the MPEP, to establish a *prima facie* case of obviousness at least three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....”

15

Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above. As shown, the Suzuki Patent fails to satisfy the requirement that the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). In teaching a series of indexing recesses spaced from each other at an angle of 15 degrees over a range of 180 degrees that serve to allow only limited ratchet-like pivotal movement of the body portion into predetermined fixed positions, the Suzuki Patent does not teach or suggest a swivel member that is variably positionable at any desired acute angle.

20

In addition, the Examiner argues that the threaded hole claimed by Applicant in claim 14 is “obvious.” That structural component is not obvious. Nothing shown or claimed in the Suzuki Patent includes a suggestion or motivation to modify the Suzuki Patent to provide structural elements that cooperate as shown and claimed in the Application.

25

Therefore, because Applicant has distinguished the cited reference and amended independent claim 11, independent claims 1 and 11 are allowable, and dependent claims 14-17 likewise also are allowable.

30

Second Rejection under 35 U.S.C. §103(a)

On page 5 of the Office Action the Examiner rejected independent claim 18 under 35 U.S.C. §103(a), stating that independent claim 18 is obvious over the Suzuki Patent”), an argument that Applicant respectfully traverses.

Again, 35 U.S.C. §103 provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference the remarks made in connection with the rejections above.

As shown, the Suzuki Patent fails to satisfy the requirement that the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). In teaching a series of indexing recesses spaced from each other at an angle of 15 degrees over a range of 180 degrees that serve to allow only limited ratchet-like pivotal movement of the body portion into predetermined fixed positions, the Suzuki Patent does not teach or suggest a swivel member that is variably positionable at any desired acute angle.

Accordingly, the premise of the Examiner’s rejection of independent claim 18 -- that “Suzuki discloses the claimed invention except for the swivel member formed a slot (sic, ‘a slot formed in the swivel member’)” -- is incorrect. Claim 18 therefore is allowable.

In addition, the Examiner argues that “mere reversal of the essential working parts of a device involves only routine skill...” See Office Action, page 7. The Examiner added that the specification “gives no criticality to the claimed limitation...” See Office Action, page 7.

Applicant presumes that the Examiner's reference to a "claimed limitation" is related to the "mere reversal of essential working parts."

Examiner's "mere reversal" argument seems to suggest that Applicant is not entitled to claims to more than one embodiment of an invention. MPEP §608.01(m), however, contemplates claims of varying scope. Also, the Office Action points to no MPEP requirement for "criticality" of a "claimed limitation" as a condition precedent for describing and claiming an alternative embodiment. In addition, as noted by Professor Irving Kayton:

The recent Federal Circuit case law...makes it clear that disclosure of only one embodiment is a specification invites unduly narrow claim construction....Instead, it is necessary to contemplate the full scope of the invention, draft claims that embrace the full scope of the invention, and support those claims with a specification describing multiple embodiments and multiple alternatives....

See *Crafting & Drafting Winning Patents*, Patent Resources Group, Inc. (2003), Vol. 1, at page 2-105.

The Examiner also cites the case of *In re Einstein*, 8 USPQ 167 as the basis for the "mere reversal argument." After considerable research, Applicant believes the correct citation is *In re Einstein*, 46 F2d 373, 18 C.C.P.A. 885, 8 USPQ 166 (1931) (emphasis added). Applicant submits that significant changes both in patent law and patent application prosecution rules have occurred since 1931, as well as since 1982 when the current Court of Appeals, Federal Circuit came into existence. In addition, Applicant respectfully submits that the *Einstein* case does not stand precisely for the proposition that "mere reversal of the essential working parts of a device involves only routine skill" in the context of alternative embodiments within an applicant's application; the case was concerned with whether elements or components found in the application were obvious over two prior patents. It was in the context of referring to two different prior patents that the court said reversing working parts of "previously patented" devices may not have constituted an invention in 1931. *In re Einstein*, 46 F2d 373, at 374. Applicant therefore believes the case is inapplicable to the present circumstances.

For the Examiner to establish a *prima facie* case of obviousness under current law the examiner must identify in the record any source of information. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). It is not enough to assert that something is "well recognized" in the art unless

that is accompanied by an indication of that assertion's origins. Generalized claims about secondary references teach or what a skilled artisan might have been aware of does not meet the test for prima facie obviousness. See In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If the Examiner is suggesting that the alternative embodiment is "merely an obvious design choice," the decision of *In re Debiczak* found that unsupported argument lacking in persuasion. *In re Debiczak*, 50 USPQ2d 1614 at 1618, citing *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Therefore, Applicant respectfully urges that independent claim 18 is not obvious over the Suzuki Patent, and that the rejection should be withdrawn.

Third Rejection under 35 U.S.C. §103(a)

On pages 5-6 of the Office Action the Examiner rejected independent claim 20 and dependent claim 21 under 35 U.S.C. §103(a), stating that those claims were obvious over the Suzuki Patent in view of U.S. Patent 6,279,919 issued August 28, 2001 to Turos ("Turos Patent"), an argument that Applicant respectfully traverses. The inventor in connection with the Turos Patent and the Application under examination are the same.

35 U.S.C. §103 provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference the remarks made in connection with the rejections above. As shown, the Suzuki Patent fails to satisfy the requirement that the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). In teaching a series of indexing recesses spaced from each other at an angle of 15 degrees over a range of 180

degrees that serve to allow only limited ratchet-like pivotal movement of the body portion into predetermined fixed positions, the Suzuki Patent does not teach or suggest a swivel member that is variably positionable at any desired acute angle.

In addition, Applicant has amended independent claim 20 to amplify fact that the swivel member may be positioned in any desired position within an acute angle during operation.

Therefore, because Applicant has distinguished the primary reference, namely the Suzuki Patent, and has amended independent claim 20, independent claims 20 is allowable, and dependent claim 21 is therefore also allowable.

Moreover, as stated in the above remarks, to establish a *prima facie* case of obviousness three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference; (2) a reasonable expectation of success; and (3) the cited reference must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....” Applicant respectfully submits that the asserted rejections of claims 20-21 do not establish a *prima facie* case of obviousness.

Restated, there must be “some objective teaching in the prior art or...knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). Nothing suggested in the secondary reference cited by the Examiner, however, or shown in the primary reference, satisfy those requirements.

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Additionally, all claim limitations must be considered, especially when missing from the alleged prior art. That is because 35 U.S.C. §103 is concerned with differences between the subject matter sought to be patented, and the alleged prior art, with the subject matter sought to be patented viewed as a whole. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (emphasis added).

Therefore, Applicant respectfully urges that independent claims 20 and 21 are not obvious over the Suzuki Patent in view of the Turos Patent, and that the rejections should be withdrawn.

Fourth Rejection under 35 U.S.C. §103(a)

5 On page 6 of the Office Action the Examiner rejected dependent claims 22-25 that depend from independent claim 20 under 35 U.S.C. §103(a), stating that those claims are obvious over the Suzuki Patent in view of the Turos Patent in further view of U.S. Patent No. 1,435,288 issued on October 10, 1921 to Gifford, *et al.* ("Gifford Patent"), an argument that Applicant respectfully traverses.

10 Once again, 35 U.S.C. §103 provides:

- 15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20 Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

25 Applicant adopts and incorporates by reference the remarks made in connection with the rejections above. As shown, the Suzuki Patent fails to satisfy the requirement that the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). In teaching a series of indexing recesses spaced from each other at an angle of 15 degrees over a range of 180 degrees that serve to allow only limited ratchet-like pivotal movement of the body portion into predetermined fixed positions, the Suzuki Patent does not teach or suggest a swivel member that is variably positionable at any desired acute angle.

30 In addition, Applicant has amended independent claim 20 to amplify fact that the swivel member may be positioned in any desired position within an acute angle during operation.

Therefore, because Applicant has distinguished the primary reference, namely the Suzuki Patent, and has amended independent claim 20, independent claims 20 is allowable, and therefore dependent claims 22-25 also are allowable.

In addition, The Examiner argues that the Gifford Patent “teaches a tool having a rod/handle (11) having a hexagonal shape,” and concludes that it would have been obvious to combine the hexagonal shape with the Suzuki Patent and Turos Patent “for the purpose of providing ease of grip/handling.” Nothing stated in the Gifford Patent provides any reason for the hexagonal shape. Also, “most if not all inventions arise from a combination of old elements...Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant.” See In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) (emphasis added). No such motivation, suggestion, or teaching is shown.

Applicant therefore urges that claims 22-25 are not obvious over the Suzuki Patent in view of the Turos Patent in further view of the Gifford Patent, and that the rejections therefore should be withdrawn.

Declaration Not “Insufficient”

Applicant submitted a Declaration with the Reply to the first office action.

The Examiner stated that the Declaration of David Norgen was “insufficient” to overcome the Examiner’s original rejections.

The rules governing submission of declarations of those skilled in the art do not provide for summarily rejecting the entirety of a declaration for “insufficiency.”

In addition, the Declaration is entitled to be accorded deference as evidence from, and assessments by, a user of the shaping tool, and therefore of a person skilled in the art. That requirement is confirmed in the MPEP: declarations containing evidence of unexpected results, commercial success, and long-felt but unsolved needs “must be considered by the examiner in determining the issue of obviousness....” See MPEP §716.01(a). The Declaration clearly includes sufficient nexus to be accorded considerable weight.

Thus, when the declarant asserts that “the device shown in the Suzuki Patent lacks that locking capacity...and as a result, during use the Suzuki device vibrates and shakes, which can lead to imperfect shaping work,” that is the observation of one skilled in the art. The declarant also stated that “device shown in the Suzuki Patent has not been widely accepted in the industry.” Accordingly, reasonable weight should be given such a statement. See MPEP §716.01(c).

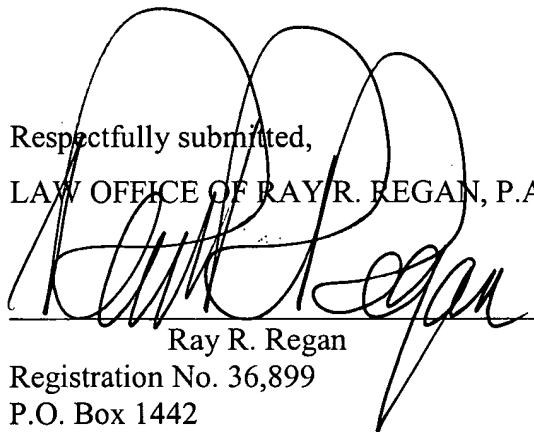
To say only that no matter what the declaration states, the Examiner would have preferred more information is to forget that the examination of patent applications is an *ex parte* procedure, not adversarial.

The Declaration should have been given considerable weight by the Examiner.

Conclusions

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims.

Respectfully submitted,
LAW OFFICE OF RAY R. REGAN, P.A.


Ray R. Regan
Registration No. 36,899
P.O. Box 1442
Corrales, New Mexico 87048
Telephone (505) 897-7200
Facsimile (505) 897-7201
E-mail rayregan@rayregan.com